

REMARKS

The Applicants have reviewed the Office Action dated January 25, 2006 in which the claims were not compliant under 37 CFR 1.121, which responded to the Applicant's bona fide attempt to reply to a Final Office action on April 6, 2005. To expedite prosecution on the merits, the Applicants have cancelled claims 9-10, 12-16, and 38-30 and added claims 31-45, which correspond with claims 9-10, 12-16, and 38-30. This amendment with the following remarks is a substitute and a replacement for the Applicant's Preliminary Amendment filed on April 6, 2005. The Applicants respectfully submit that the Notice of Non-Compliant Amendment should be withdrawn.

By virtue of this amendment, claims 31-45 are pending in the application. Claims 9-10, 12-16, and 38 - 30 have been cancelled without prejudice. An examination of this application is respectfully requested in light of this preliminary amendment and the present remarks.

On January 14, 2005, the Examiner issued a **final** Office Action on the application (09/757,901) to which this Request for Continuing Examination claims priority. In the **final** Office Action, the Examiner rejected claims 9, 10, 14-16, 38, 24, 27 and 28 under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (U.S. Patent No. 6,571,279) in view of Dowling et al. (U.S. Patent No. 6,522,875).

Newly added independent claims 31, 35, 38, and 42 recite the following:

determining a presence of at least one item inside a sales location, the at least one item being identified within the user profile data;

generating a personalized advertisement which includes one of:

a map providing directional information to an inner position within the sales location of the at least one item in response to the at least one item being present inside the sales location; and

a map providing directional information of an inner aisle layout of the sales location in response to the at least one item being not present within the sales location... (emphasis added)

The present invention is directed to a combination of Global Positioning System (GPS), Personal Data Assistant (PDA), and wireless communications in order to create a more personalized advertising experience. The invention creates and presents advertising content founded on individual user profiles integrated with the physical geographic location of a consumer. The present invention solves the problem of advertising tailored so that it is appropriate to both the user and their current location by including a customer's profile and his / her current location into the advertising message. Also, the invention integrates location tracking, e.g. GPS technology, with a personal electronic calendaring system. Further, an advertising message is more personalized by using a relative address / directions that start from the current customer's location. **This information can be provided in the form of driving directions or a map**, using the current physical position of the user as a start address. See Abstract of the specification of the Applicants' invention and page 26, third para.

As the Examiner recognizes, on page 3 of the January 14, 2005 Office action, the Herz reference does not teach "generating a personalized advertisement which includes a map." The Examiner then goes on to combine Dowling et al.¹

The Dowling reference does show the generation of directions and/or a map based on the content of a user profile. However, Dowling only gives an example of directions to, and a map of, the inside of a shopping mall to locate a store. Dowling, col. 14, line 58 – col. 15, line 10.

However, the Dowling reference does not teach rendering a map to an item's

¹ Applicants make no statement whether such combination is even proper.

inner position within a sales location if the item is determined to be in stock and, alternatively, rendering a map of an aisle layout within a sales location if the item is out of stock.

The specification of the instant application discloses that "the invention can also provide directions within a large building (e.g. a shopping mall), or within a store (direction to the desired product, which aisle or shelf the product or service is in or the equivalent)." Page 8, first paragraph and FIG. 7, items 726-734 and pages 24-26 referring to FIG. 7. Therefore, the user is provided with a map that will guide them directly to the exact item's location within a store if the item is in stock. Alternatively, the user is provided with a map of the interior aisle layout of the store if the item is not in stock. Accordingly, independent claims 31, 35, 38, and 42 distinguish over Hertz taken alone and/or in view of Dowling for at least this reason.

The Examiner recites 35 U.S.C. § 103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter as a whole and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention as a whole. Herz et al. taken alone and/or in view of Dowling et al. simply does not teach or suggest "a map providing directional information to an inner position within the sales location of the at least one item in response to the at least one item being present inside the sales location; and a map providing directional information of an inner aisle layout of the sales location in response to the at least one item being not present within the sales location."

Continuing further, when there is no suggestion or teaching in the prior art for that disclosed in the application, the suggestion cannot come from the Applicants' own specification. As the Federal Circuit has repeatedly warned against using the Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American

Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is accordingly submitted that Herz et al., whether taken alone or in combination with Dowling et al., neither shows nor suggests the features of claims 31, 35, 38 or 42. Claims 32-34 depend from claim 31; claims 36-37 depend from claim 35; claims 39-41 depend from claim 38; and claims 43-45 depend from claim 42. Since dependent claims contain all the limitations of the independent claims, claims 32-24, 36-37, 39-41, and 43-45 distinguish over Herz et al. and Dowling et al., as well.

No new matter has been added. This preliminary amendment has been filed to place the application in better form for examination. An action on the merits is respectfully requested.

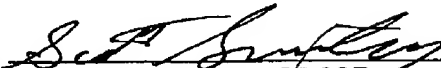
CONCLUSION

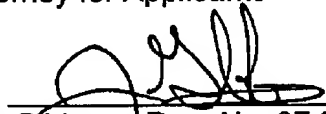
Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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